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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,889	03/26/2004	Yoshifumi Tanimoto	042089	7798

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EXAMINER	
SAMS, MATTHEW C	

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/809,889	TANIMOTO, YOSHIFUMI	
	Examiner	Art Unit	
	Matthew C. Sams	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement filed on 3/26/2004 has been considered.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-19 are rejected under 35 U.S.C. 102(a & e) as being anticipated by Dorenbosch et al. (US 2002/0173308).

Regarding claim 1, Dorenbosch teaches a communication device (Fig. 1 [12]) with a means for logging into a server that offers instant message service (Fig. 1 [16]), means for receiving an instant message having a forwarding destination (Page 2 [0020]), means for storing the instant message (Page 2 [0020]), means for detecting whether or not a user designated as the forwarding destination is logged in the server (Page 1 [0018]), and means for transmitting to the forwarding destination, the instant message stored in the means for storing when the user logs into the server. (Page 2 [0020])

Regarding claim 2, Dorenbosch teaches a means for adding to an instant message to be transmitted to the user, information of a transmitter included in the instant message received by the means for receiving. (Fig. 3, Page 2 [0021] and Page 3 [0032])

Regarding claim 3, Dorenbosch teaches a means for transmitting to the transmitter, when a prescribed period of time elapses after the means for receiving receives the instant message, an instant message indicating such a fact. (Fig. 4 [56 & 58] and Page 2 [0023])

Regarding claim 4, Dorenbosch teaches a means for detecting whether or not the user is logged in server. (Page 2 [0023])

Regarding claim 5, Dorenbosch teaches the means for receiving receives a first instant message including a transmission destination, a transmitter, a forwarding destination and a main text. (Fig. 2 [24], Fig. 3 [43] and Page 2 [0020-0023])

Regarding claim 6, Dorenbosch teaches a means for generating a second instant message including a transmission destination, a transmitter, a forwarder and main text in accordance with the first instant message. (Fig. 2 [24], Fig. 3 [43], Page 2 [0020-0023] and Page 3 [0032])

Regarding claim 7, Dorenbosch teaches a communication device (Fig. 1 [12]) with a means for logging into a server that offers instant message service (Fig. 1 [16]), means for receiving from a client terminal of a forwarder, an instant message including identification information of a client terminal of a forwarding destination (Page 2 [0020] and Fig. 1 [10]), means for storing the instant message (Page 2 [0020]), means for detecting whether or not a user designated as the forwarding destination is under active status (Page 1 [0018]), and means for transmitting the instant message stored in the storing means when the client terminal is under active status. (Page 2 [0020] and Fig. 7)

Regarding claim 8, the limitations of claim 8 are rejected as being the same reason set forth above in claim 2.

Regarding claim 9, Dorenbosch teaches a means for transmitting to the client terminal of the forwarder, when a prescribed period of time elapses after the means for receiving receives the instant message and the instant message fails to be transmitted to the client terminal of the forwarding destination an instant message indicating such a fact. (Fig. 6 [86])

Regarding claim 10, Dorenbosch teaches the means for detecting whether or not the client terminal of the forwarding destination is under the active status by inquiring the server. (Page 1 [0002 & 0004] and Page 2 [0020])

Regarding claim 11, Dorenbosch teaches the means for receiving from the client terminal of forwarder, a first instant message including identification information of the communication device as transmission destination information, identification information of the client terminal of the forwarder as transmitter information, identification information of the client terminal of the forwarding destination as forwarding destination information and main text. (Fig. 2 [24], Fig. 3 [43] and Page 2 [0020-0023])

Regarding claim 12, Dorenbosch teaches a means for generating a second instant message including the identification information of the client terminal of the forwarding destination as transmission destination information, the identification information of the communication device as transmitter information, the identification information of the client terminal of the forwarder as forwarder information, and main text in accordance with the first instant message, wherein the client terminal of the forwarding destination is under the active status, the means for transmitting transmits the second instant message to the client terminal of the forwarding destination. (Fig. 2 [24], Fig. 3 [43], Page 2 [0020-0023] and Page 3 [0032])

Regarding claim 13, Dorenbosch teaches a communication method comprising detecting by a terminal of a forwarder, whether or not a user of a terminal of a forwarding destination is logged in an instant message server (Page 2 [0023]), transmitting an instant message including identification information of the terminal of the

forwarding destination from the terminal of the forwarder to a communication device when the user of the forwarding destination is not logged in the instant message server (Page 2 [0020] and Fig. 6 [86]), storing the instant message received from the terminal of the forwarder in means for storing of the communication device (Page 2 [0020]), detecting by the communication device, whether or not the user of the forwarding destination designated as the terminal of the forwarding destination is logged in the instant message server (Page 2 [0023]) and transmitting the instant message stored in the means for storing from the communication device to the terminal of the forwarding destination when the user of the forwarding destination logs into the instant message server. (Page 2 [0020-0024])

Regarding claim 14, Dorenbosch teaches adding an instant message to be transmitted from the communication device to the terminal of the forwarding destination, transmitter information included in the instant message which the communication device received from the terminal of the forwarder. (Fig. 3, Page 2 [0021] and Page 3 [0032])

Regarding claim 15, Dorenbosch teaches the step of transmitting, when a prescribed period of time elapses after the communication device receives the instant message form the terminal of the forwarder, an instant message indicating such a fact from the communication device to the terminal of the forwarder. (Fig. 4 [56 & 58] and Page 2 [0023])

Regarding claim 16, Dorenbosch teaches the step of transmitting the instant message from the terminal of the forwarder to the terminal of the forwarding destination without intervening the communication device when the user of the forwarding

destination is logged in the instant message server. (Page 2 [0020] through Page 3 [0027])

Regarding claim 17, the limitations of claim 17 are rejected as being the same reason set forth above in claim 4.

Regarding claim 18, Dorenbosch teaches receiving a first instant message including a transmission destination, a transmitter, a forwarding destination and main text form the terminal of the forwarder. (Fig. 2 [24], Fig. 3 [43] and Page 2 [0020-0023])

Regarding claim 19, Dorenbosch teaches a means for generating a second instant message including a transmission destination, a transmitter, a forwarder and main text as an instant message to be transmitted to the terminal of the forwarding destination in accordance with the first instant message. (Fig. 2 [24], Fig. 3 [43], Page 2 [0020-0023] and Page 3 [0032])

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-6,301,609 to Aravamudan et al. regarding user definable instant messaging groups.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCS
6/9/2006

LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER